

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

After entry of the foregoing amendment, Claims 11-24 are pending in the present application. Claims 11-20 are amended; and Claims 21-24 are added by the present amendment. No new matter is added.

In the outstanding Office Action, the title was objected to; Claims 12, 14, and 20 were objected to; Claims 11, 13, 17, and 20 were rejected under 35 USC 103(a) as unpatentable over U.S. Patent No. 4,812,911 to Ohshima et al (hereinafter "Oshima") in view of U.S. Patent No. 3,692,394 to Bauer II; Claims 12 and 14 were rejected under 35 USC 103(a) as unpatentable over Ohshima and Bauer II in view of U.S. Patent No. 4,667,226 to Glenn; Claim 15 was rejected under 35 USC 103(a) as unpatentable over Ohshima, Bauer II, and Glenn in view of UK Patent No. GB2175172A to Childs; and Claims 16, 18, and 19 were rejected under 35 USC 103(a) as unpatentable over Ohshima and Glenn in view of U.S. Patent No. 4,758,905 to Okada et al (hereinafter "Okada").

Regarding the objection to the title, the title is amended in view of the Examiner's comments. Accordingly, Applicant respectfully requests that the objection to the title be withdrawn.

Regarding the objections to Claims 12, 14, and 20, those claims are amended in view of the Examiner's comments. Accordingly, Applicant respectfully requests that the objections to those claims be withdrawn.

Addressing now the rejection of Claims 11-13, 17, and 20 under 35 U.S.C. § 103(a) as unpatentable over Ohshima in view of Bauer II, that rejection is respectfully traversed.

Amended independent Claim 11 is directed to a camera having an optical axis. The camera includes:

a spectral splitter configured to split light of the optical axis into spectral components;

photoelectric-effect sensors each configured to receive a respective one of the spectral components;

an optical viewfinder configured to provide an off-field view outside the field of the photoelectric-effect sensors and located off the optical axis;

a shutter configured to allow the light of the optical axis to pass through the shutter, in an open position, towards the objective focal plane crossing the optical axis and *configured to direct the light passing along the optical axis*, in a closed position, *towards the optical viewfinder*.

As emphasized, independent Claim 11 recites photoelectric-effect sensors; an optical viewfinder configured to provide an off-field view outside the field of the photoelectric-effect sensors; and a shutter configured to direct the light passing along the optical axis towards the optical viewfinder. Claims 12-20 depend directly or indirectly from independent Claim 11.

The outstanding Office Action cites Oshima as teaching each feature of the claimed invention, except for the optical viewfinder; and cites Bauer II as teaching the optical viewfinder. More particularly, the Action cites Oshima's camera, modified to include the Bauers II's optical viewfinder, as teaching the claimed invention. As motivation for the proposed substitution, the Action states, "One of ordinary skill in the art would have provided the optical viewfinder of Bauer II in order to enable a cameraman to aim the camera in preparation for the next use of the camera".¹

Applicants note that Bauer II's viewfinder does not provide an off-field view outside the field of photoelectric-effect sensors; and there is no indication that Bauer II's viewfinder would provide an off-field view outside the field of Oshima's sensors if substituted into Oshima's camera. Moreover, Bauer II's viewfinder does not provide an off-field view outside the field of the image provided to the film of Bauer II's camera. In view of these

¹ Office Action, 8/11/2004, page 3.

deficiencies, the modification of Oshima in view of Bauer II does not teach each feature of the claimed invention.

Further, the modification of Oshima in view of Bauer is improper for at least two reasons. First, the cited motivation does not suggest the substitution that is the difference between the claimed invention and Oshima.² Even assuming, *arguendo*, the cited motivation is correct, the cited motivation merely suggests the substitution of a viewfinder allowing the preparation for a next film shot; and does not suggest the substitution of a viewfinder providing an off-field view. Second, the cited motivation is incorrect, because there is no suggestion that an operator of Oshima's camera could not view a next shot without inclusion of Bauer II's viewfinder. As is known in the art, an operator of a television/video camera can view a next shot on the monitor to which the camera's image signal is provided. Further, in view of the added cost and design implications of substituting Bauer II's viewfinder, one skilled in the art would not make that substitution when a view is already provided to a monitor.

Applicants further note that the claimed shutter is (1) located upline of the photoelectric-effect sensors along the optical axis and (2) directs light to the viewfinder. Thus, the viewfinder produces an image via light received from upline of the photodetecting component. None of the applied references teach such an "upline viewfinder" for a camera having photoelectric-effect sensors (e.g., a digital camera). Though Bauer II teaches an upline viewfinder, that is only because Bauer II's camera is a *true film camera* (i.e., because the viewfinder image cannot be produced via light received downline of the film). There is no suggestion within the references to modify a camera having photoelectric-effect sensors to include an upline viewfinder; nonetheless, an optical viewfinder providing an off-field view.

² See In re Vaack, 20 USPQ2d 1438, 1444 (CAFC 1991), holding that the applied references themselves or the general knowledge of one skilled in the art must suggest the substitution that is the difference between the claimed invention and the prior art.

Respectfully, the suggestion to modify Oshima's camera to include an upline viewfinder is derived from Applicants' disclosure that such an arrangement provides an off-field view.

Accordingly, for the reasons stated above, Applicant respectfully requests that the rejection of Claims 11, 13, 17, and 20, under 35 U.S.C. 103(a) as unpatentable over Ohshima in view of Bauer II, be withdrawn. As the references cited by the remaining rejections, summarized above, do not cure the above-noted deficiencies of Oshima in view of Bauer II, Applicants respectfully request that those rejections also be withdrawn.

New dependent Claim 21 is added to recite further structure of the claimed invention. With respect thereto, Applicants note that Oshima does not teach an adapter configured receive light passed through a focal plane of an optical axis. In fact, positioning Oshima's adapter downline of the focal plane would render that adapter unfit for its intended purpose, because the adapter is intended to maintain the position of the focal plane while adding a detachable high speed shutter upline of that focal plane.

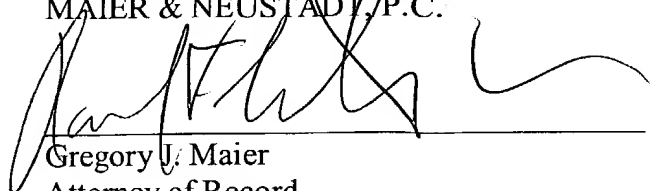
New Claims 22-24 are added to recite the claimed invention in a varying scope. More particularly, new independent Claims 22 and 23 are added to recite claimed features in means-plus-function terminology; and new independent Claim 24 is added to claim the invention in method claim format.³

³ Support for new Claims 21-24 may be found at least within the claims as originally-filed; and within the Specification, page 2, line 24 – page 3, line 13..

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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